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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No.	: 09/546,966	Confirmation No. 4186
Applicant	: David T. Pollock et al.	
Filed	: April 11, 2000	
Art Unit	: 3731	
Examiner	: Vy Q. Bui	
Title	: SINGLE-PIECE THICK-WALLED ENDOPROSTHESIS	
Docket No.:	: ENDOS 51639	
Customer No.	: 24201	March 25, 2008

REPLY TO THE SUPPLEMENTAL EXAMINER'S ANSWER

MS: Appeal Brief Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is being filed in response to the Supplemental Examiner's Answer dated January 25, 2008. Please charge any fee due in connection with the filing of this paper to our Deposit Account No. 06-2425.

I. TIMING OF THE SUPPLEMENTAL EXAMINER'S ANSWER

Appellant strongly objects to the filing of the Supplemental Examiner's Answer and request that this Supplemental Answer be stricken from the record. Appellant filed its Reply Brief on **May 23, 2006** and now, more than **twenty (20) months** later, the Examiner is filing a Supplemental Answer to this Reply Brief. The Examiner cannot possibly argue that the Supplemental Examiner's Answer has been timely filed and the Examiner provides no explanation as to why the Supplemental Examiner's Answer could not have been filed earlier. For these reasons alone, the Supplemental Examiner's Answer should not be considered in these proceedings and should be stricken from the record.

II. THE SUPPLEMENTAL EXAMINER'S ANSWER RAISES NEW GROUNDS OF REJECTION

The Examiner is now apparently taking the position that the element identified as a hinge 23 in the Drasler patent may be considered the "longitudinal member" recited in the pending claims. Reference is made to page 2, lines 5-7 of the Supplemental Answer which reads as follows:

Therefore, strut 10 including section 23 together can be considered "a longitudinal member", or **even section 23 can be considered as "a longitudinal member" as well.** (Emphasis Added)

Throughout prosecution and in the Examiner's Answer, the Examiner has taken the position that the strut 10 together with section 23 (the hinge) forms the longitudinal

member. In the untimely filed Supplemental Examiner's Answer, the Examiner is apparently now taking the position the hinge 23 alone can form the longitudinal member. The Examiner has argued throughout prosecution that the longitudinal member is the strut 10 and hinge 23. This change in the Examiner's position constitutes a new ground for rejection and should be stricken from the record or simply disregarded by the Board as being in violation of 37 C.F.R. § 41.43 (a)(2) which prohibits presenting a new grounds of rejection in a supplemental examiner's answer. This rule is designed to prevent an Examiner from introducing new grounds or positions that were not raised previously during prosecution or in the Examiner's Answer. Appellant would be prejudiced in not being afforded an adequate opportunity to address this new position which has now been asserted by the Examiner. Accordingly, this new position should not be considered by the Board.

III. A. Group I: Claims 1-3, 5, 7-10, 36 and 37

However, in the event that the Board still consider the Examiner's new position in this Supplemental Answer, it is easy to see that the Examiner is grasping at any argument to support his position. Claim 1 specifically requires a hollow cylinder having an inner diameter, an outer diameter and a radial thickness. The hinge 23 shown in Figure 5 has an upward incline as it extends from the strut 10. Therefore, the cylinder shown in the Drasler patent which forms this hinge 23 must have multiple inner diameters and multiple radial thicknesses in order to form this structure. However, this is not the structure recited in the claims, namely, a hollow cylinder having an inner diameter, an outer

diameter and a radial thickness. Therefore, the Drasler patent lacks the basic structure recited in the pending claims.

Furthermore, as previously highlighted in the Appellants Opening and Reply Brief, the Drasler patent does not teach the subject matter of claims 36 or 37 which depend directly from claim 1. Clearly, the Drasler patent does not teach, as is recited in claim 36, at least one longitudinal member both having a radial thickness which is greater than a circumferential width as well as such structure extending a length of one cell. This is particularly true given the Examiner's new position that only the hinge 23 forms the longitudinal member. The Examiner's position that claim 36 does not require the longitudinal member to extend the whole length of the one cell is also terribly misplaced. A person reading claim 36 easily recognizes that the claim calls for the longitudinal member to extend the entire length of one cell. The Drasler patent fails to disclose this structure using any one of the Examiner's numerous position as to which structure in the Drasler patent constitutes the longitudinal member.

The Examiner's position that the profiles of the strut 10 and hinge 23 are not different completely disregards the meaning of the word profile as used in the claim and disclosed in the specification. The Drasler patent clearly does not teach an apparatus lacking a hinge as recited in claim 37. The Drasler patent fails to disclose the structure using the Examiner's new position that the hinge 23 alone can constitute the longitudinal member.

B. Group II: Claims 12-15 and 38

For similar reasons as those provided above in Section III A, it is respectfully submitted that Drasler et al. does not meet the limitations recited in claims 12-15 and 38. Thus, it is submitted that the Examiner erred in rejecting these claims.

C. Group III: Claims 17, 20, 22, 23 and 39

For similar reasons as those provided above in Section III A, it is respectfully submitted that Drasler et al. does not meet the limitations recited in claims 17, 20, 22, 23 and 39. Thus, it is submitted that the Examiner erred in rejecting these claims.

IV. CONCLUSION

For all the reasons stated above, Appellant submits that the Supplemental Examiner's Answer has been untimely filed and raises new grounds and positions of rejection. Therefore, the Board should disregard and strike the Supplemental Examiner's Answer from the record. Moreover, the Examiner's position disregards the clear teachings of the Drasler patent. Appellant respectfully submits that the Examiner has erred in rejecting claims 1-3, 5, 7-10, 12-15, 17, 20, 22, 23, 36, 38 and 39. It is respectfully

requested that the Board reverse the rejection of these claims and pass these pending claims to issue.

Respectfully submitted,

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